

### **REMARKS/ARGUMENTS**

The Office Action of July 1, 2008, has been reviewed and the following remarks are responsive thereto. Claim 59 has been amended to correct dependency. No new matter has been added. Claims 21, 23-26, 29-32, 35-37, 41-45 and 51-59 remain pending upon entry of the present amendment. Reconsideration and allowance of the instant application is respectfully requested.

#### ***Interview Summary***

Applicants thank the Examiner for the courtesies extended during the telephonic interview of June 19, 2008. Applicants adopt the substance of the Examiner's Interview Summary in connection with the remarks below.

#### ***Claim Objection***

Claim 59 has been amended to correct its dependency.

#### ***Claim Rejections Under 35 U.S.C. §103(a)***

Claims 21-26, 29-32, 35-37, 41-50 and 55-59 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Piosenka *et al.* (U.S. Patent No. 5,926,756, "Piosenka") in view of Shanahan (U.S. Patent No. 7,149,509, "Shanahan"). Claims 51-54 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Piosenka. These rejections are respectfully traversed.

Independent claim 21 recites, *inter alia*, receiving a selection of a data category prior to initializing a data transfer between first and second portable devices and receiving a first set of personalization information to be transmitted to the second portable device upon initializing the data transfer. Claim 21 further recites automatically selecting a second set of personalized information to be transmitted to the second portable device from the first set of personalized information based on the selected data category. In response to Applicants' response filed February 21, 2008, the Office Action asserts at p. 2 that Shanahan teaches a first portable device receiving a first set of personalized information for data transferring and a second set of personalized information automatically selected based on a selected data category. The Office Action goes on to allege that Shanahan teaches the modification of data files during

transferring/downloading if the data file exceeds the available memory size of a device. Applicants respectfully disagree.

Contrary to the Office Action's assertions, Shanahan does not teach or suggest selection of a data category. The cited passages of Shanahan merely describe the selection of information (e.g., an audio sample, Internet configuration information) for transfer to a device through a programmer device. Col. 2, ll. 1-4, Col. 3, ll. 33-35. The selection of information such as audio samples and Internet configuration information, however, does not describe the selection of a data *category*. While it may be argued that each selected piece of information corresponds to a category of data, the selection of the piece of information does not constitute the selection of the category of data to which it corresponds. Neither Piosenka nor the Office Action's taking of Official Notice cures these deficiencies of Shanahan. Accordingly, claim 1 is allowable for at least these reasons.

Further, neither Piosenka nor Shanahan, either separately or in combination, teaches or suggests modifying a second set of personalized information selected from a first set of personalized information in accordance with data field information received from a second portable device. The Office Action alleges that such features are taught by Shanahan at col. 6, ll. 43-54. However, the cited passage is limited to requesting a user modification of an information request upon determining the memory of a destination device is insufficient from all of the information. Thus, even assuming, without conceding, that compression or conversion of data (e.g., a music file) describes automatic selection of a second set of personalized information from a first set of personalized information, Shanahan still fails to teach or suggest that the converted data (i.e., the alleged second set of personalized information) is subsequently modified in accordance with the amount of memory available (i.e., the alleged data field information). Rather, Shanahan discloses that a user must change or cancel his or her *information request* or receive *all* of the requested information in a scrolling manner if the memory is insufficient. Col. 6, ll. 43-54. Neither Piosenka nor the Office Action's taking of Official Notice cures these additional deficiencies of Shanahan. Claim 21 is thus allowable for this additional reason.

Claims 29, 35, 41, 51 and 55 recite features similar to those discussed above with respect to claim 21 and are thus allowable for substantially the same reasons as claim 21.

Moreover, the Office Action, in its rejection of claim 51, concedes that Piosenka does not expressly teach that the second data record corresponds to at least one of: a calendar, a phonebook, a message box and a call register. Instead, the Office Action asserts that it would have been obvious to one of ordinary skill in the art to resize the data record of calendar and phonebook, etc. such that transmitted data would not exceed the capacity of the ending terminal. No support is given for such an assertion and thus this rejection is respectfully traversed for this additional reason.

Claims 23-26, 29-32, 35-37, 42-45 and 52-54 are dependent on claims 21, 29, 35, 41, and 51, respectively, and are thus allowable for at least the same reasons as their base independent claims and further in view of the novel and non-obvious features recited therein. For example, claims 44 and 53 recite, *inter alia*, modifying the first data record in accordance with the data field size information including truncating at least a portion of the first data record. Contrary to the Office Action's assertions, Piosenka and Shanahan are devoid of such features. With respect to claim 44, the Office Action asserts that Shanahan teaches "truncating at least a portion of the data first record" at col. 3, lines 44-64. However, the cited passage relates to converting between format types (e.g., from MIDI to WAV or MPEG) and there is no teaching or suggestion of truncating a portion of the data record as part of the conversion or at all. With respect to claim 53, the Office Action asserts that such a feature is described at col. 6, ll. 43-54. Again, Applicants respectfully note that the cited passage makes no mention of truncation. At most, Shanahan describes transmitting information "in a scrolling fashion...so that all requested information may be reviewed, albeit in sections," which does not describe truncation of the information. Indeed, Shanahan describes transmitting all of the information without teaching or suggesting truncation (note that Shanahan does not describe physically changing the information). Accordingly, claim 44 is also allowable for this additional reason.

Additionally, claim 59 relates to flagging a data record to indicate that the data record is empty, wherein the flagged data record is not evaluated for transfer to the first portable device. In addressing claims 58 and 59, collectively, the Office Action concedes that Shanahan and Dahm do not teach flagging a data record and halting transferring if the data record is empty and instead takes Official Notice, alleging that it is notoriously well known in the art to notify a user that something he/she is looking for is not there. Without addressing the merits of the Official

Notice, Applicants respectfully note that the Official Notice does not describe the features recited in claims 58 and 59 and thus fails to cure the admitted deficiencies of Shanahan and Dahm. In particular, nowhere does the Office Action address flagging of a data record to indicate the data record is empty, wherein the flagged record is not evaluated for transfer. Pioesenka does not cure these deficiencies. Claim 59 is thus allowable for at least these reasons.

### **CONCLUSION**

All rejections having been addressed, Applicants respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3156.

Respectfully submitted,  
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